

### **Remarks/Arguments**

Applicants have received and carefully reviewed the Office Action of the Examiner mailed October 15, 2009. Currently, claims 1-40, and 44-46 remain pending of which claims 9, 16-18, 22, 23, 30-32, and 35-37 were previously withdrawn. Claims 1-8, 10-15, 19-21, 24-29, 33, 34, 38-40, and 44-46 have been rejected. Favorable consideration of the following remarks is respectfully requested.

### **Claim Rejections – 35 USC § 103**

Claims 1, 4-7, 10, 13, 20, 21, 24, 27, 34, 38-40, and 44-46 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. Although the Examiner has not identified the Daniel reference as required by:

37 CFR 1.104. (d)(1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated.

In the interest of advancing prosecution, it will be assumed that the intended reference is (U.S. Patent No. 6,171,327), hereinafter Daniel. If this assumption is incorrect, the Examiner is invited to provide the correct reference in a future non-final Office Action. After careful review, Applicant must respectfully traverse this rejection.

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). Nowhere does Daniel appear to disclose a two part shaft joined by a connector fixedly connecting the proximal and the distal section and a filter attached to the shaft.

Instead, Daniel appears to disclose a filter disposed about an elongate guidewire having a proximal end and a distal end. The guidewire and associated filter appear to be slidably disposed within a catheter. For example, the cited Fig. 3 depicts: “a view of a shaft of a catheter in accordance with the present invention including a collapsible portion”. (Col. 2, lines 62-63.) Catheter 112 appears to be a delivery catheter adapted to deliver the guidewire and filter at least partially within its lumen and slidably disposed therein. Accordingly, catheter 112 does not appear to teach, disclose, or otherwise render

obvious a shaft to which a filter may be coupled. The Examiner has made reference to Figure 9 with the assertion that Daniel teaches a filter 21 coupled to the shaft. Applicant respectfully disagrees, noting that the filter of Fig. 9 appears to be coupled to guidewire 26 and the combination is slidably disposed within housing 118 at the distal end of two part (14, 16) catheter 112. One of ordinary skill in the art would appreciate that filter is not coupled to the catheter, but rather is coupled to the guidewire as discussed at col. 4, lines 30-31, and the combination of guidewire and filter is disposed within delivery catheter 12 of Fig. 1, said catheter comprising proximal section 14 and distal section 16 which are analogous to delivery catheter 112, proximal section 114, and distal section 116 of Figs. 3, 4, and 9 among others. See for example, column 7, lines 1-7 in which the removal of catheter 112 from standard length wire 26 is described.

Therefore, Daniel does not appear to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness. Applicant respectfully requests that the rejections of independent claims 1, 10, and 44 be withdrawn.

If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). (MPEP 2143.03)

Accordingly, claims 45 and 46, which depend from nonobvious independent claim 1, also are believed to be nonobvious and Applicant respectfully requests that the rejections be withdrawn.

Although the Examiner has not explicitly discussed claims 4-7, 13, 20, 21, 24, 27, 34, and 38-40, it is believed that the analysis of Daniel as applied to independent claims 1 and 10 above also apply to these claims as well. Accordingly, Applicant respectfully requests that the rejection of independent claims 24, 39, and 40 be withdrawn as well.

Claims 4-7, 13, 20, 21, 27, 34, and 38, which depend from nonobvious independent claims 1, 10, and 24 respectively, are also believed to be nonobvious and Applicant respectfully requests that the rejections be withdrawn.

Claims 2, 3, 6, 11-12, and 25-26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel et al. in view of Stevens et al. (U.S. Patent No. 6,029,671), hereinafter Stevens. In the interest of advancing prosecution, it will again be assumed that the intended reference is (U.S. Patent No. 6,171,327), hereinafter Daniel. If this assumption is incorrect, the Examiner is invited to provide the correct reference in a future non-final Office Action. After careful review, Applicant must respectfully traverse this rejection.

Stevens is asserted to “teach the proximal section comprises a first material (stainless steel) and the distal section comprises a second material (nickel titanium alloy) that is different from the first material (fig. 4A, disclose the proximal section 440 and distal section 446 have different material)”, the Examiner having acknowledged that the distinction is absent from the disclosure of Daniel.

Applicant respectfully disagrees with the Examiners reading of the reference. Reference numerals 440 and 446 appear only in the single paragraph found at column 13, lines 44-65 of Stevens. That paragraph appears to disclose a unitary shaping element 440 having a proximal end 442, a distal end 444, and a preshaped distal portion 446. Shaping element 440 may be “stainless steel, nickel titanium alloy, or other biocompatible material with a bending stiffness greater than that of shaft 332”. There appears to be no indication that Stevens contemplates that more than a single material will be used for any given shaping element 440. It appears that the Examiner may not have noticed that hollow shaft 332 is advanced over shaping element 440 and thus it does not appear possible for the two to be joined and fixedly secured to each other. As seen in the cited Fig. 4A, element 322 is the lumen of partitioning device 320 having a distal portion 332. Shaping element 440 is positionable in the lumen 322 in the shaft and will shape the distal portion 332 by virtue of having a bending stiffness greater than that of shaft distal portion 332 when the shaft is advanced to the ascending aorta over the shaping element 440. The shaft appears to be constructed entirely of a flexible polymeric material.

In view of the above, it should be apparent that Stevens does not appear to disclose a single shaft having a proximal section and a distal section of different materials, said shaft having a filter coupled to the shaft. The core shafts of both Daniels and Stevens appear to be formed in a single piece from a single material. Accordingly

Daniels, Stevens and/or the combination of Daniels and Stevens appear not to teach all the claim limitations, as is required to establish a *prima facie* case of obviousness and Applicant respectfully submits that independent claims 1, 10, and 24 are nonobvious over Daniel in view of Stevens. Accordingly claims 2, 3, 6, 11-12, and 25-26, which depend from nonobvious independent claims 1, 10, and 24 respectively, are also believed to be nonobvious and Applicant respectfully requests that the rejections be withdrawn.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Further examination is respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date: Jan 19, 2010



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